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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,579	02/11/2004	Stephen C. Gordy	15436.204.3	3034
22913	7590	06/28/2007		
WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111			EXAMINER HO, DUC CHI	
			ART UNIT	PAPER NUMBER
			2616	
			MAIL DATE	DELIVERY MODE
			06/28/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/776,579

Applicant(s)

GORDY ET AL.

Examiner

Duc C. Ho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10, 12 and 14-22 is/are allowed.
- 6) ☒ Claim(s) 23 is/are rejected.
- 7) ☒ Claim(s) 11, 13, and 24-32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>07-19-04</u> . | 6) <input type="checkbox"/> Other: _____  |

### ***Claim Objections***

1. Claims 11, 13, and 23 are objected to because of the following informalities: (1) For positive recitation of a limitation, Applicant is requested to delete the usage of "being capable of" in lines 10, and 14. (2) Applicant is requested to replace the usage of "device data" in lines 10, and 20 with "kill packet(s)" for clarity of the claim language. The same remark applies to claim 11, and 13.

Appropriate correction is required.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 23 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 26 of U.S. Patent No. 6,898,632. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Regarding claim 23, see lines 1-24 (see claim 26 of the patent 6,898,632 at col. 28, lines 42-67).

For claim 23, the scope of this claim is different than that of claim 26 of the patent 6,898,632 by having an additional limitation "at least one management port that can be connected to a remote computer, the at least one management port permitting access to the network data and further being capable of receiving management data from the remote computer".

It has been held that adding a functional limitation is an obvious expedient if the remaining elements perform the same function as before. Therefore, omission of a reference element whose function is not needed would be obvious to one skilled in the art.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

5. Claim 23 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 15 of copending Application No. 10/735,417. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Regarding claim 23, see lines 1-24 (see claim 15 of the copending Application No. 10/735,417, lines 1-21).

For claim 23, the scope of this claim is different than that of claim 15 of the copending Application No. 10/735,417 at the following: (1) Claim 23 recites " a first

network port; a second network port”, while claim 15 recites “a first tap port; a second tap port”. (2) Claim 15 includes additional limitation “wherein the first tap port and second tap port are configured to operate in a plurality of modes, each mode being defined by enabling or disabling the ability of the first tap port and second tap port to receive network data and device data”.

It has been held that changing the language of the claim, and adding a functional limitation thereby changing the scope of the claims slightly is an obvious expedient if the remaining elements perform the same function as before; therefore omission of a reference element whose function is not needed would be obvious to one skilled in the art.

#### ***Allowable subject matter***

6. Claims 1-10, 12, and 14-22 are allowed.
7. Claim 23 would be allowable if rewritten or amended to overcome the double patenting rejection(s), set forth in this Office action.
8. Claims 24-32 are objected to as being independent upon a rejected base claim, but would be allowable if the rejected base claim overcame the double patenting rejection(s), set forth in this Office action.
9. Claims 11, and 13 would be allowable if amended to overcome the objection as set for the in this Office action.

#### ***Conclusion***

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10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Klinker et al.(US 2006/0182034) ; Frattura et al.(US 2006/0059163) ; Palmer, JR. et al(US2005/0120243) ; Klinker et al. (US 2003/0133443) are cited to show network tap with integrated circuitry, which is considered pertinent to the claimed invention.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Ho whose telephone number is (571) 272-3147. The examiner can normally be reached on Monday through Thursday from 7:30 am to 6:00 pm.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (571) 272-3134.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Ho whose telephone number is (571) 272-3147. The examiner can normally be reached on Monday through Thursday from 7:30 am to 6:00 pm.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (571) 272-3134.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner



Duc Ho

06-20-07